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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,298	10/16/2003	Donagh O'Shaughnessy	P1369 US	9179

28390 7590 02/08/2005
MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
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SANTA ROSA, CA 95403

EXAMINER

OSELE, MARK A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,298

Applicant(s)

O'SHAUGHNESSY ET AL.

Examiner

Mark A Osele

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01202004, 01232004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller, Jr. Mueller, Jr. shows the method of welding two overlapping portions of polymeric material comprising a catheter shaft and a balloon neck to create a joint and applying a tensile force to the joint region to elongate the joint region, thus thinning the joint region (column 2, lines 42-64, Figs. 3, 4).

3. Claims 1, 2, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Vannan et al. Vannan et al. shows the method of welding two overlapping portions of polymeric material to create a joint and applying a tensile force to the joint region to elongate the joint region, thus thinning the joint region (column 6, lines 29-42, Figs. 5, 6). Regarding claim 6, the tensile force appears to be applied to a cold joint.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1734

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 7, and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over NL 6814117. NL 6814117 shows the method of welding two overlapping portions of polymeric material to create a joint and applying a tensile force to the joint region (English Abstract--XP002256166). Although the abstract is silent as to the joint region being thinned by the tensile force, it appears from the progressively angled cross hatching of the webs in the joint region that the webs are stretched to the point of being thinned (See Fig. 1).

Regarding claims 7 and 8, the joint is heated by the application of hot air from element 6.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over NL 6814117. As shown in paragraph 5 above, NL 6814117 shows the claimed limitations except for the amount of tensile force applied. Absent the showing of unexpected results, the amount of force required to achieve the desired elongation would be determined by one of ordinary skill in the art as a matter of routine optimization.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller, Jr. in view of NL 6814117. As shown in paragraph 2 above, Mueller, Jr. shows the claimed limitations except for the tensile force applied between two clamped regions. NL 6814117 shows the elastomeric material clamped on both sides of the joint region for stretching (Fig. 1). It would have been obvious to one of ordinary skill in the art at

Art Unit: 1734

the time the invention was made to clamp both sides of the joint region of Mueller, Jr. because NL 6814117 shows the clamping to hold the overlapped layers together and because the clamps provide attaching members for the stretching means.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 5 recites the limitation "the balloon neck" in line 1. There is insufficient antecedent basis for this limitation in the claim. For the purpose of examination, it was presumed that claim 5 was meant to depend from claim 4.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mark A. Osele', is positioned above the printed name.

MARK A. OSELE
PRIMARY EXAMINER

February 4, 2005